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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,447	03/26/2004	Su-hyun Nam	Q80019	8134

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WASHINGTON, DC 20037

EXAMINER
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HENEGHAN, MATTHEW E

ART UNIT	PAPER NUMBER
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2134

MAIL DATE	DELIVERY MODE
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08/31/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/809,447

Applicant(s)

NAM ET AL.

Examiner

Matthew Heneghan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 4 IDS's.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

1. Claims 1-34 have been examined.

### ***Priority***

2. The instant application claims priority to U.S. Provisional Patent Application No. 60/486,916, filed 15 July 2003.

3. The instant application claims priority to Korea Patent Application No. 10-2003-0036004, filed 4 June 2003 and Korea Patent Application No. 10-2003-0059603, filed 27 August 2003.

### ***Information Disclosure Statement***

4. The following Information Disclosure Statements in the instant application have been fully considered:

IDS filed 27 August 2004.

IDS filed 25 May 2005.

IDS filed 18 October 2006.

IDS filed 23 April 2007.

***Drawings***

5. Figures 1 and 2 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g).
6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: items 620 and 660 in figure 6; item 725 in figure 7A; and items 752, 756, and 770 in figure 7B.
7. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 27-34 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility. Each claim recites a determination, but has no positive steps that are based upon that determination, and therefore do not recite a useful, concrete, and tangible result.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1, 2, 9-13, and 17-34 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 25 of copending Application No. 10/809,524. Although the conflicting claims are not identical,

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they are not patentably distinct from each other because the claims of the '524 application fully anticipate the claims of the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1, 2, 9-13, and 16-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2001/0017828 to Yamada in view of U.S. Patent No. 4,118,789 to Casto et al.

Regarding claims 1, 2, 9-13, 18, 19, 21, 23, 25, 27, 28, 30, 31, and 33, Yamada discloses a system in which two sets of CCI information are recorded onto a medium (the DGCCI and WACCI), each of which may be used in reproducing an AV signal (see paragraph 71). A reproducing device may receive a video signal and then decrypt according to the copy control modes of the CCIs (see paragraph 88).

Yamada does not disclose that the process be contingent upon the CCI values being equal.

Casto discloses a system in which protected control instructions are read from two different locations and execution is stopped if they are not equal (see abstract), as this protects critical portions from unauthorized change (see column 1, lines 44-46).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Yamada to stop execution if the two CCI control modes are not equal, in view of Casto, to protect from unauthorized change.

Regarding claim 16, Casto discloses the displaying of an error light in the event of a mismatch (see column 14, lines 35-38), but does not specify that a message be displayed.

Official notice is given that it is well-known in the art to display error messages in error situations, in order to inform the user of the specific nature of the error.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Yamada and Casto by displaying an error message in the event of a mismatch, in order to inform the user of the specific nature of the error.

Regarding claims 17, 20, 22, 24, 26, 29, 32, and 34, since the invention is executed on a computer, Yamada and Casto's invention inherently comprises instructions embodied on a computer-readable medium.

11. Claim 3-8, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2001/0017828 to Yamada in view of U.S.

Patent No. 4,118,789 to Casto et al. as applied to claims 1 and 12 above, and further in view of U.S. Patent No. 7,031,942 to Ogino et al.

Regarding claims 3 and 8, Yamada only discloses control modes for copy free, copy restricted, and copy inhibited (see figure 13).

Ogino discloses analogous control modes and signals allowing for encrypted or unencrypted free copying, one-time only encrypted copying and encrypted copy inhibition (see figures 8A and 8B).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to use Ogino's analogous control code mapping in Yamada and Casto's invention.

Regarding claim 4, 14, and 15, Ogino discloses that the decryption key is derived from the disc key, which must be extracted from the AV stream (by the key generating unit), and the content is decrypted according to the control code (see Ogino, column 15, lines 11-30). The comparison of control codes is as per Casto.

Regarding claim 5, Ogino's decrypting signal is provided to the reproduction processing unit (see column 15, line 23), which is part of the reproducing apparatus that stores outputted signals onto a recording medium (see column 14, lines 34-63).

Regarding claim 6, the creation of the key is contingent upon the control codes (see Ogino, column 15, lines 11-14).

Regarding claim 7, Ogino's control codes are stored before usage, and Casto's modification requires a comparator.



***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew E. Heneghan, whose telephone number is (571) 272-3834. The examiner can normally be reached on Monday-Friday from 8:30 AM - 4:30 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Zand, can be reached at (571) 272-3811.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Or faxed to:**

(571) 273-3800

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Matthew Heneghan/

August 28, 2007

Patent Examiner (FSA), USPTO Art Unit 2134